

IN THE DRAWINGS

The attached sheets of drawings include changes to Figs. 1-3. These sheets, which include Figs. 1-3, replace the original sheets including Figs. 1-3.

Attachment: Three Replacement Sheets

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1-10 are currently pending in the present application, Claims 1, 5, and 8 having been amended by way of the present amendment to clarify features previously presented. No new matter is added.

In the Official Action, the drawings were objected to; Claims 5 and 8 were rejected under 35 U.S.C. §112, second paragraph; Claims 1, 3, and 4 were provisionally rejected on the grounds of non-statutory double patenting as unpatentable over Claim 1 of co-pending Application No. 10/519,833; and Claims 1-10 were rejected under 35 U.S.C. §103(a) as unpatentable over Masaharu (JP 2003-029795) and in view of the background art.

Regarding the objection to the drawings, Applicant respectfully submits that Figs. 1-3 are described under the section describing "Background Art," and as such, are properly labeled as "Background Art." Nowhere in the specification are Figs. 1-3 referred to as "Prior Art." Accordingly, the objection to the drawings is believed to be overcome.

Regarding the 35 U.S.C. §112, second paragraph, rejection, Claims 5 and 8 have been amended to address the issues set forth on page 2 of the Official Action. Thus, the 35 U.S.C. §112, second paragraph rejection is believed to have been overcome.

Regarding the provisional rejection of Claims 1, 3, and 4 on the grounds of non-statutory double patenting over Claim 1 of co-pending application number 10/519,833, Applicant respectfully requests that this rejection be held in abeyance until the present application is in condition for allowance for the following reasons. A terminal disclaimer can be filed, if the claims in the present application remain obvious in view of the claims of the cited U.S. patent application (10/519,833) at the time of allowance of the present application. Furthermore, additional amendments (if needed for allowance of these claims) may eliminate

the double-patenting rejection, making the filing of a Terminal Disclaimer at this time premature. Indeed, M.P.E.P. § 804.02 IV states that, prior to issuance, it is necessary to disclaim each one of the double patenting references applied. Hence, Applicant respectfully requests that the examiner contact the undersigned should the present amendments and arguments be accepted and should the present application be otherwise in condition for allowance. At that time, a terminal disclaimer, if warranted, can be supplied to expedite issuance of this case.

Regarding the rejection of Claims 1-10 were rejected under 35 U.S.C. §103(a) as unpatentable over Masaharu (JP 2003-029795) and in view of the background art, Applicant respectfully traverses the rejection.

By way of review, Claim 1 recites a data transferring system for transferring audio data between a first recording medium and a second recording medium, including

a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes *pointers to tracks of audio data contained in each of the first sets*; and

controlling means for *transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred to the second recording medium.*

Masaharu is directed to data volume considerations for digital memory players.

Masaharu describes a favorite list file containing tracks of music, and including the track names and the data volume of each track of music. According to Masaharu, the contents of the data from the favorite list file (tracks of music) are transferred from a PC to the digital memory player. Once the contents are transferred, the user can associate that list with a name (“preservation destination list name”) and the contents therein are stored on the user’s PC. Then, if the user changes the memory of the of the digital memory player (to upgrade, for example), the player can be easily restored to include the music contents of the favorite list file without the user having to recreate it, by using the “preservation destination list name.”

However, Masaharu does not disclose or suggest “a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets,” **and** “controlling means for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred to the second recording medium,” as recited in Claim 1.

Figs. 1-3 are described in the background art section as systems used by conventional recording and reproducing apparatuses. Fig. 1 merely illustrates the basic concept of a play list and an album. Thus, as seen in Fig. 1, Play List 1 describes only pointers to songs, and not songs themselves. Accordingly, even if Song 1 (link), Song 2 (link), etc. are deleted from Play List 1, only the links are removed, not the corresponding songs, such as Song 1 and Song 2.

Figs. 2 and 3 illustrate a conventional way for transferring songs corresponding to Play List 1 to a recording and reproducing apparatus. As seen in Fig. 3, Play List 1 contains *links* to songs from both Album 1 and Album 2. However, during transfer from the personal computer to the recording and reproducing apparatus, the concept of the play list is lost and the songs are recorded as a structural concept of an album, i.e. as the songs themselves. That is, Album 3 is created in the recording and reproducing apparatus in place of Play List 1, and the links to songs are not maintained. Accordingly, the data associated with which songs correspond to Album 1 and which songs correspond with Album 2 is lost.

In Fig. 3, the concept of a play list is kept after transfer to the recording and reproducing apparatus. However, Fig. 3 differs from the structure of Fig. 2 in that, while the links between the songs in the play list and the albums are kept (Song 1 has a pointer to Song 1 of Album 1, Song 14 has a pointer to Song 14 of Album 2, etc.), the songs not on Play List

1 are no longer associated with Albums 1 and 2. As can be seen, Songs 3-4 and 6-7 of Album 1 are missing from Album 1 after transfer, and Songs 9-12 are no missing from Album 2 after transfer. Accordingly, data structure and consequently, integrity is lost in the structures of Figs. 2 and 3.

In contrast, in an exemplary embodiment of the claimed invention, Applicant's Figure 52 shows an example of Applicant's data transferring system for transferring audio data between a first recording medium and a second recording medium. As can be seen from Fig. 52, the data structures of Albums 1 and 2 and Play List 1 are all preserved after transfer. Therefore, after transfer, all of Song 1-7 remain associated with Album 1, all of Songs 8-14 remain associated with Album 2, and Play List 1 includes links to Songs 1, 2, 2, 8, 5, 13, and 14. The links between Play List 1 and Albums 1 and 2 are also maintained, i.e., Song 1 (link), Song 2 (link), ... , and Song 14 (link), as described in Play List 1, still point to the songs referenced from Album 1 and Album 2, just as they did before transfer.

Therefore, Masaharu and the background art do not disclose or suggest, either separately or combined, "a second set, defining a play list, that describes the reproduction order of audio data contained in at least one first set and recorded in the first recording medium and that describes pointers to tracks of audio data contained in each of the first sets" **and** "controlling means for transferring all tracks of audio data contained in the first sets that contain audio data described in the second set from the first recording medium to the second recording medium when audio data described in the second set are transferred to the second recording medium," as recited in Claim 1.

Therefore, Masaharu and the background art do not disclose or suggest, either separately or combined, "a data transferring system," as defined in independent Claim 1. Accordingly, independent Claim 1 (and Claims 2-4 dependent therefrom) patentably defines over the applied art.

Independent Claims 5 and 8, while differing in scope and statutory class from Claim 1, patentably define over Masaharu in view of the background art for substantially the same reasons as Claim 1. Accordingly, it is respectfully submitted that Masaharu and the background art do not anticipate or make obvious the features of independent Claims 5 and 8. Therefore, independent Claims 5 and 8 (and the claims dependent therefrom) are believed to patentably define over Masaharu in view of the background art.

Since Applicant has not substantively amended the claims in response to any rejection on the merits, a further rejection of these claims based on newly cited prior art in the next communication **cannot properly be considered a Final Office Action.**


Consequently, in view of the present amendment and in light of the above discussion, the outstanding grounds for rejection are believed to have been overcome. The application as amended herewith is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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